

Remarks

The Office Action of July 31, 2007 has been received and reviewed. With claims 1, 26, 30, and 38 having been amended, claims 19-20 having been canceled, and no claims having been added, the pending claims are claims 1-7, 10, 12-18, 21-22, 26, 27, 29, 30, 32, 33, 36-38, and 40. Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

Examiner Interview

Applicants' Representative, Matthew Adams (Reg. No. 43, 459), along with associate Matthew Goeden, appreciates the time of Examiner Castellano in discussing this matter during a telephone interview on September 12, 2007. Although various rejections including the double patenting rejections and the anticipation rejections of claims 30 and 38 were discussed at this time, no agreement was reached regarding the allowability of the rejected claims. However, it is believed that the claim amendments and remarks presented herein adhere to the substance of the interview and, as a result, entry and consideration are requested.

Claim Status

Applicants note that the Office Action substantively rejects claim 17, a claim that had previously been identified as withdrawn. If claim 17 has been rejoined, official notice of the same is requested in the next Official Communication.

Claim Amendments

Claims 1 and 26 have been amended to recite a perforated first roller surface. Support for this amendment may be found in the application as filed. *See, e.g.*, page 6, lines 6-7, FIGS. 16-17, original claim 20.

Claims 30 and 38 have been amended to recite a "first roller surface for distributing liquid over a roller-type liquid applicator." Support for these amendments may be found in the application as filed. *See, e.g.*, page 6, lines 8-9, and FIGS. 13, 16, & 18. Claim 38 has further been amended to improve readability.

The 35 U.S.C. § 102 Rejections

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.
M.P.E.P. § 2131 (citation omitted).

- Claims 30, 32, 38, and 40 (Hanssen)

Claims 30, 32, 38, and 40 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hanssen (U.S. Patent No. 3,825,970). Applicants traverse this rejection.

Hanssen describes a paint roller retaining frame having an integral spray shield. *See Hanssen*, column 1, lines 6-8. Applicants submit that, among other deficiencies, no teaching is identified within the disclosure of Hanssen that describes a container including each and every recitation of independent claims 30 and 38 as required for anticipation.

For example, nothing is identified within the disclosure of Hanssen that teaches a first roller surface as recited in claims 30 and 38. The Office Action equates "a small longitudinal strip" of the inside surface of the elongated cylinder disclosed in Hanssen to the first roller surface as claimed. *See Office Action*, July 31, 2007, page 2. Applicants submit, however, that the inside surface of the elongated cylinder of Hanssen is clearly not a roller surface as the latter is recited in claims 30 and 38.

Nonetheless, independent claims 30 and 38 have been amended herein to recite explicitly that the first roller surface is for distributing liquid over a roller-type liquid applicator. This amendment is intended to make explicit what was already implied, e.g., this amendment is not narrowing. The inside surface of the elongated cylinder of Hanssen is clearly not for distributing liquid over a roller-type liquid applicator. In fact, it is unclear how Hanssen's inner surface could ever be accessed for such a use. As such, Hanssen does not teach each and every recitation of independent claims 30 and 38 as required for anticipation.

For at least the above reasons, Applicants submit that claims 30 and 38 are not anticipated by Hanssen. Dependent claims 32 and 40, which depend from either independent claim 30 or 38, are also novel over Hanssen for the same reasons presented above. Moreover, these dependent claims recite additional elements that further support patentability. Reconsideration and withdrawal of this rejection are, therefore, requested.

- Claims 30, 32, and 40 (Dumesnil, Jr.)

Claims 30, 32, and 40 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dumesnil, Jr. (U.S. Patent No. 4,107,815). Applicants traverse this rejection.

Applicants note that dependent claim 40 was rejected under 35 U.S.C. § 102(b) as being anticipated by Dumesnil, Jr. while the parent of dependent claim 40, independent claim 38, was not.

Dumesnil, Jr. describes "a paint tray . . . , a paint transfer roller, and mount means for rotatably supporting said paint transfer roller on said paint tray." *Dumesnil, Jr.*, column 1, lines 34-37.

Applicants submit that, among other deficiencies, no teaching is identified within the disclosure of Dumesnil, Jr. that describes a container including each and every recitation of independent claims 30 and 38 as required for anticipation.

For example, nothing is identified within the disclosure of Dumesnil, Jr. that teaches a first roller surface for distributing liquid over a roller-type liquid applicator (as recited in claims 30 and 38). The Office Action equates "part of the outer surface of the transfer roller" disclosed in Dumesnil, Jr. to the roller surface as claimed. *See Office Action*, July 31, 2007, page 3. However, no part of the outer surface of the transfer roller of Dumesnil, Jr. is for distributing liquid over a roller-type liquid applicator. Instead, the transfer roller of Dumesnil, Jr. is for "applying paint to pad painters." *Dumesnil, Jr.*, column 1, lines 32-33. In fact, it is unclear even how the transfer roller of Dumesnil, Jr. could distribute paint onto a roller-type liquid applicator (e.g., it is unclear how the desired relative rotation between the transfer roller and a roller-type applicator would occur during use). As such, Dumesnil, Jr. does not teach each and every recitation of independent claims 30 and 38 as required for anticipation.

For at least the above reasons, Applicants submit that claims 30 and 38 are not anticipated by Dumesnil, Jr. Dependent claims 32 and 40, which depend from either independent claim 30 or 38, are also submit to be novel over Dumesnil, Jr. for the same reasons presented above. Moreover, claims 32 and 40 recite additional elements that further support patentability.

Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. § 103 Rejections

- Claims 1-7, 10, 12-18, 26, 27, 29, 33, and 36-38 (Dumesnil, Jr. in view of Bedrossian)

Claims 1-7, 10, 12-18, 26, 27, 29, 33, and 36-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dumesnil, Jr. in view of Bedrossian (U.S. Patent No. 5,314,061).

Applicants traverse this rejection.

The Office Action states the following: "Dumesnil discloses the invention except for the lid. Bedrossian teaches a lid to cover a paint receptacle." *Office Action*, July 31, 2007, page 3. As such, the Office Action appears to present Bedrossian merely to provide "a lid."

Applicants submit that Dumesnil, Jr. in view of Bedrossian does not teach, or even suggest, all the recitations of claims 1-7, 10, 12-18, 26, 27, 29, 33, and 36-38 as to establish obviousness.

For example, claim 1 recites "a lid to cover an open top of the container body and to form a relatively tight seal therewith," claim 26 recites "a removable and resealable lid operable to form a relatively tight seal with the container body and to selectively cover the opening," and claim 33 recites "a selectively removable lid operable to seal the open top." It is unclear how the lid of Bedrossian could form a relatively tight seal with the tray or seal the open top of Dumesnil, Jr., e.g., the interconnect hooks 30, 32 extend above the walls 18, 20 of the tray. If this rejection is maintained, Applicants request clarification on this matter.

Further for example, claims 1 and 26 now recite a perforated first roller surface. The perforated roller surface was originally recited in now-canceled claims 19-20 which, while not part of the present rejection, were rejected over Dumesnil, Jr. in view of Bedrossian and further in view of Drum (U.S. Patent No. 2,659,917), the latter which illustrates a perforate member 9. Accordingly, that rejection will be addressed now in the context of amended claims 1 and 26.

Among other deficiencies, Applicants submit that the Office Action has failed to provide any motivation to combine the teachings of Dumesnil, Jr. with those of Bedrossian and/or Drum. In fact the perforate member 9 of Drum clearly teaches away from combination with either the transfer roller of Dumesnil or the "rear side wall 15" of Drum.

For example, Dumesnil, Jr. indicates that the transfer roller, with the aid of the longitudinally extending ribs, forms channels that function as "paint receptacles" to carry paint. *See, e.g.*, Col. 3, Lines 23-30. Yet, if the transfer roller were perforated as is the member 9 of Drum, it is unclear how it would carry sufficient paint to the pad painter as the paint would merely flow through the perforations and into the transfer roller.

However, the Office Action asserts that "it would have been obvious to modify the Bedrossian surface to be perforated to allow excess paint to fall through the surface." *See, Office Action*, page 4. This assertion is strenuously traversed. The "Bedrossian surface" is clearly a "rear side wall 15" of the bucket, e.g., it forms an exterior surface of the paint container. If it were perforated as the Office Action suggests, paint passing through the surface would flow out of the container.

For at least the above reasons, Drum clearly teaches away from combination with both Dumesnil, Jr. and Bedrossian.

Moreover, with respect to claim 26, Dumesnil, Jr. in view of Bedrossian fails to teach or even suggest that the alleged first roller surface is, when in the first position, located above the designated volume of liquid.

Further for example, as recited above, Dumesnil, Jr. does not teach, or even suggest a first roller surface for distributing liquid over a roller-type liquid applicator as recited in claims 30 (from which claim 33 depends) and 38. Nothing is identified within the disclosure of Bedrossian that remedies the deficiencies of Dumesnil, Jr.

For at least the above reasons, Applicants submit that claims 1, 26, 30, and 38 are nonobvious over Dumesnil, Jr. in view of Bedrossian. Dependent claims 2-7, 10, 12-18, 27, 29, 33, and 36-37, which depend from either independent claim 1, 26, 30, or 38, are also submitted to be nonobvious over Dumesnil, Jr. in view of Bedrossian not only because of their dependence, but also due to the particular subject matter recited therein. For example, the Office Action has not identified the stop members recited in claims 13-14, nor the second roller surface of claim 15.

Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

- Claims 19-20 (Dumesnil, Jr. in view of Bedrossian/Drum)

Claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dumesnil, Jr. in view of Bedrossian as applied to claim 1, and further in view of Drum (U.S. Patent No. 2,659,917). While these claims have been canceled herein rendering their respective rejections moot, subject matter of these claims is now included in independent claim 1. Accordingly, this rejection is addressed above in the context of the obviousness rejection of claim 1.

- Claims 21-22 (Dumesnil, Jr. in view of Bedrossian/Carling et al.)

Claims 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dumesnil, Jr. in view of Bedrossian as applied to claim 1, and further in view of Carling et al. (U.S. Patent No. 5,992,106).

As stated above, it is submitted that Dumesnil, Jr. in view of Bedrossian fails to establish obviousness with respect to claim 1 (from which claims 21 and 22 depend), and the disclosure of Carling et al. does not remedy these deficiencies. Rather, Carling et al. is relied upon to teach an "X-shaped support structure." Further, it is unclear as to what motivation exists to combine the teachings of Carling et al. with those of Dumesnil, Jr. and Bedrossian.

For at least these reasons, Applicants submit that claims 21 and 22 are nonobvious over Dumesnil, Jr. in view of Bedrossian and further in view of Carling et al. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Double Patenting Rejections

Claims 1-7, 10, 12-22, 26, 27, 29, 30, 32, 33, 36-38, and 40 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of Prokop et al. (U.S. Patent No. D524,501) (hereinafter Prokop et al. '501) in view of Bedrossian (U.S. Patent No. 5,314,061). Claims 1-7, 10, 12-22, 26, 27, 29, 30, 32, 33, 36-38, and 40 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of Prokop et al. (U.S. Patent No. D524,003) (hereinafter Prokop et al. '003) in view of Bedrossian. Applicants traverse these rejections.

It is noted that Prokop et al. '501 and Prokop et al. '003 (along with a third design patent application to Prokop et al. that has now issued as D518,265) were cited as pending patent applications to the Patent Office in an Information Disclosure Statement filed July 30, 2004. It is further noted that claims 19-20 have been canceled herein, rendering their respective rejections moot.

In *Carman Industries, Inc. v. Wahl et al.*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983), the court noted that "double patenting will be found in a design/utility situation if the two patents cross-read" or are obvious in light of the subject matter of the other. *Id.* at 487, emphasis added. Thus, the proper test for making design/utility double patenting rejections is two-way obviousness (see also, e.g., M.P.E.P. § 1504.06(II) (citing *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999)), "[I]n design-utility situations, a two-way obviousness determination is necessary for the rejection to be proper"). In making these determinations, the disclosure of the reference document may not be used as prior art. *Carman Industries* at 487. Further, in the case of a design-utility double patenting rejection, "[t]he examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the drawings." M.P.E.P. § 1504.06.

Applicants submit that the Office Action has failed to establish two-way obviousness between the current claims and Prokop et al. '501 in view of Bedrossian, or Prokop et al. '003 in view of Bedrossian. At the very least, Applicants submit that Prokop et al. '501/Prokop et al. '003 in view of Bedrossian are not obvious in view of the current claims. For example, Applicants submit that the claimed designs of Prokop et al. '501 and Prokop et al. '003, each in view of Bedrossian, could not be recreated merely from the utility claims of the instant application.

The Examiner, in the interview, stated that the Office need only show one-way obviousness in design/utility situations, asserting in the Interview Summary that the M.P.E.P. discussion of this subject matter is "case specific." However, absolutely no legal support for this assertion has been provided. Should this rejection be maintained, **explicit legal support for the Office's position, including an explanation as to why it is contrary to the above-identified case law, is requested in the next Official Communication.**

Amendment and Response

Page 14 of 14

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For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

Reconsideration and withdrawal of these double patenting rejections are, therefore, requested.

Summary

It is submitted that the pending claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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CERTIFICATE UNDER 37 CFR § 1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR § 1.6(d) to the Patent and Trademark Office, addressed to **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30th day of November, 2007, at 9:30 am (Central Time).

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